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10/624,140

07/21/2003

John C. Bucher

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05/19/2004

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EXAMINER

CHOI, JACOB Y

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,140

Applicant(s)

BUCHER ET AL.

Examiner

Jacob Y Choi

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/21/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "34" and "12T" have both been used to designate top side. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Note: reference character "34" in Figure 1 should be pointing at the mounting hole of the mounting plate

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 82 & 56. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

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4. Claims 1 & 2 are objected to because of the following informalities: both term subbracket and plate is used to designate female subbracket, which makes claims unclear. In addition, every claim must end with a period. Appropriate correction is required.

Note: applicant is advised to use a single term to describe a single element to avoid any confusion

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 25 recites the limitation "said sub-bracket" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,595,664. Although the conflicting claims are not identical, they are not patentably distinct from each other as listed below:

Claim 1 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 2 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 3 of current application # 10/624,140 & USPN 6,595,664 claim 2.
Claim 4 of current application # 10/624,140 & USPN 6,595,664 claim 2.
Claim 5 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 6 of current application # 10/624,140 & USPN 6,595,664 claim 3.
Claim 7 of current application # 10/624,140 & USPN 6,595,664 claim 4.
Claim 8 of current application # 10/624,140 & USPN 6,595,664 claims 5 & 8.
Claim 9 of current application # 10/624,140 & USPN 6,595,664 claim 11.
Claim 10 of current application # 10/624,140 & USPN 6,595,664 claim 6.
Claim 11 of current application # 10/624,140 & USPN 6,595,664 claims 7 & 8.
Claim 12 of current application # 10/624,140 & USPN 6,595,664 claim 8.
Claim 13 of current application # 10/624,140 & USPN 6,595,664 claim 8.
Claim 14 of current application # 10/624,140 & USPN 6,595,664 claim 8.
Claim 15 of current application # 10/624,140 & USPN 6,595,664 claim 11.
Claim 16 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 17 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 18 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 19 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 20 of current application # 10/624,140 & USPN 6,595,664 claim 11.
Claim 21 of current application # 10/624,140 & USPN 6,595,664 claim 11.
Claim 22 of current application # 10/624,140 & USPN 6,595,664 claim 11.
Claim 23 of current application # 10/624,140 & USPN 6,595,664 claim 11.
Claim 24 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.
Claim 25 of current application # 10/624,140 & USPN 6,595,664 claims 1, 5 & 8.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1, 2, 6, 7, 8, 9, 10, 16, 17, 18, 24 & 25 rejected under 35 U.S.C. 102(b) as being anticipated by Johnstone (USPN 5,727,867).

Regarding claims 1, 16, 17, 18, 24 & 25, Johnstone discloses a male / first subbracket (reference #18) for connection to one of the light fixture (reference #12), a female / second subbracket (reference #20) for connection to the electrical box (reference #36), the subbrackets being complementarily configured for coupling to each other (shown in Figures 1-8).

Note: functional language does not hold any patentable weight

Regarding claim 2, the male subbracket comprises a stud (reference #40) and wherein the female subbracket comprises a plate for coupling to the stud (shown in Figures 1 & 6).

Regarding claim 6, Johnstone discloses the male subbracket is connected to the fixture (reference #12) and the female subbracket is connected to the electrical box (reference #36, shown in Figure 1).

Regarding claim 7, Johnstone discloses male subbracket comprises a spring clip (reference #58) for coupling with the female subbracket.

Regarding claim 8, Johnstone discloses the spring clip comprises at least one leg, which engages into the hole in the female subbracket (shown in Figure 2 & 6).

Regarding claim 9, Johnstone discloses one of the legs comprises teeth (reference #60) for engagement with an edge of the hole.

Regarding claim 10, Johnstone discloses one of the legs comprise a lip for engagement with an edge of the hole (shown in Figure 6).

10. Claims 1, 16, 17, 18, 24 & 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ursch (USPN 6,257,743).

Regarding claims 1, 16, 17, 18, 24 & 25, Ursch discloses a male / first subbracket for connection to one of the light fixture a female / second subbracket for connection to the electrical box, the subbrackets being complementarily configured for coupling to each other (shown in Figures 2-8).

11. Claims 1, 16, 17, 18, 24 & 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kowalenko et al. (USPN 5,477,439).

Regarding claims 1, 16, 17, 18, 24 & 25, Kowalenko et al. discloses a male / first subbracket for connection to one of the light fixture a female / second subbracket for connection to the electrical box, the subbrackets being complementarily configured for coupling to each other (shown in Figures 1-3).

12. Claims 1, 16, 17, 18, 24 & 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Quiogue (USPN 4,507,719).

Regarding claims 1, 16, 17, 18, 24 & 25, Quiogue discloses a male / first subbracket for connection to one of the light fixture a female / second subbracket for connection to the electrical box, the subbrackets being complementarily configured for coupling to each other (shown in Figures 2-4).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3, 4 & 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnstone (USPN 5,727,867) in view of G. F. Thomas (USPN 2,933,279).

Regarding claim 3, Johnstone discloses claimed invention, explained above. However, Johnstone does not disclose the plate comprising a leaf plate. G. F. Thomas discloses a plate (reference #10) comprises a leaf plate (reference #18) with opposing leafs (reference #18) for engaging opposing sides of the stud. It would have been obvious at the time the invention was made to person having ordinary skill in the art to combine teachings of Johnstone with G. F. Thomas, since mentioned references are relevant in art of mounting device for lighting fixture. It is known in the art that hanging a light fixture against the wall or from the wall usually requires plural (male/female) plates with desired attachment member for a proper assembly. Replacing plate of Johnstone with G. F. Thomas seems obvious to do at the time the invention was made because

Johnstone is only missing a structural limitation of leaf plate of G. F. Thomas where it is well known in the art to use an additional think plate / leaf plate in addition to the mounting plate so that the threaded stud can screw and unscrew, providing coupling with mating mounting plate.

Regarding claim 4, Johnstone in view of G. F. Thomas discloses claimed invention, explained above. In addition, Johnstone discloses a threaded stud and wherein the plate engages threads of the threaded stud (shown in Figure 1).

Regarding claim 5, Johnstone in view of G. F. Thomas discloses the male subbracket is connected to the electrical box (reference #36) and the female subbracket is connected to the fixture (reference #12, shown in Figure 1).

15. Claims 11-14, 15, 19 & 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnstone (USPN 5,727,867).

Regarding claim 11-14, Johnstone discloses the claimed invention except for a squeeze plate couple to the extensions for coupling female and male plates. It would have been obvious to one having ordinary skill in the art at the time the invention was made to supply a extension that resiliently positioned in a radially outwardly direction relative to the subbracket, since the examiner takes office Notice of the equivalence of teachings of using different method of couple two subbrackets together and equivalent element in teachings of Johnstone for their use in the same part and the selection of any of these known equivalents to function in the same way would be within the level of ordinary skill in the art.

Regarding claims 15 & 20-23, Johnstone discloses claimed invention, explained above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a simple tether to hang the fixture, since it was known in that a simple tether may be used to hang things.

Regarding claim 19, Johnstone discloses a male / first subbracket (reference #18) for connection to one of the light fixture (reference #12), a female / second subbracket (reference #20) for connection to the electrical box (reference #36), the subbrackets being complementarily configured for coupling to each other (shown in Figures 1-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange female and male subbrackets, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Conclusion


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



**THOMAS M. SEMBER
PRIMARY EXAMINER**